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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/376,487 08/18/99 MISHRA

A 121-175

EXAMINER

HM12/1106

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WEBMAN, E

ART UNIT

PAPER NUMBER

1617

DATE MAILED:

11/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/376427

Applicant(s)

MISHRA

Examiner

WGBMAN

Group Art Unit

1617

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 7/27/01
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-12, 15-44 is/are pending in the application.
- Of the above claim(s) 44 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-12, 15-43 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 4-6, 10
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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The elections of species requirements are withdrawn in view of prior art over the Markush groups containing them.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12, 15-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pejaver et al (US '302) in view of Carpenter.

Pejaver et al teach propofol emulsions comprising low concentrations of soybean oil (Abstract). 160-200mm droplets are specified (column 2 lines 56). Isopropyl myristate is disclosed (column 3 line 1). Natural and artificially manipulate phospholipids are specified as surfactants (column 3 lines 10-18). 0.1-57% propofol and 0.1-3% immiscible solvent are specified (column 3 lines 1-7). ~~1-19.8% is specified (column 3 line 49).~~

It would have been obvious to one of ordinary skill to add mannitol to the composition of Pejaver et al to achieve the beneficial effect of a tonicity agent in view of Carpenter.

As to the claimed properties, they must be possessed by the obvious composition because it is the same as that claimed.

As to the claimed sealed vial, such a storage means is well known in the art.

Carpenter teaches propofol compositions (title) comprising mannitol as a tonicity agent (column 3 lines 1-7). 1-19.8 % is specified (column 3 line ~~98~~⁴⁹).

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Claims 1-12, 15-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 (d) "of" is indefinite. In claims 1, 15 "Little" is vague; it is subjective.

In claims 2, 20-22, 28 "one or more" and "selected from" are vague. If a Markush Group is intended, "The Group consisting of" should BE added after "selected" and the last member be made "and mixtures thereof." The preceding members should be separated by commas. "Or" should be deleted.

In claim 2 "minimum" and "minimized" are vague; they are subjective. In claim 3 "suitable" is vague for the same reason.

In claim 15 "substantially limiting or inhibiting" is vague; what percent?

In claims 28-29 "these" is vague; what follows has no clear antecedent.

In claim 37 the elements of the mixture are unclear due to the "OR".

Claim 8 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim Should refer to other claims in the alternative only. See MPEP § 608.01(n).

Accordingly, the claim 8 not been further treated on the merits.

This application does not contain an abstract of the disclosure as required by 37

CFR 1.72(b). An abstract on a separate sheet is required.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward J. Webman whose telephone number is (703) -308-4432. The examiner can normally be reached on Monday through Friday from 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, M. Moezie, can be reached on (703) -308-0570. The fax phone number for the organization where this application or proceeding is assigned is (703) -305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) -308-1235.

Webman/LR

October 10, 2001


EDWARD J. WEBMAN
PRIMARY EXAMINER
GROUP 1500